



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,371	07/03/2003	Kazunari Motohashi	075834.00409	4837

33448 7590 11/13/2007

ROBERT J. DEPKE
LEWIS T. STEADMAN
ROCKEY, DEPKE & LYONS, LLC
SUITE 5450 SEARS TOWER
CHICAGO, IL 60606-6306

EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED: 11/13/2007

Please find below and/or attached an Office communication concerning this application or proceeding.

Notification of Non-Compliant Appeal Brief (37 CFR 41.37)	Application No. 10/613,371	Applicant(s) MOTOHASHI, KAZUNARI	
	Examiner Kevin M. Bernatz	Art Unit 1794	


--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 28 August 2006 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.
EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.

1. ☐ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☐ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☐ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner **and relied upon by appellant in the appeal**, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☐ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

See Continuation Sheet.


 Kevin M. Bernatz, PhD
 Primary Examiner

KMB
 October 22, 2007

Continuation of 10. Other (including any explanation in support of the above items): Appellants are requested to comply with the remand by the Board of Patent Appeals and Interferences (BPAI), dated August 31, 2007. Specifically, as noted on page 3 of the remand, "Appellant will be notified of any deficiency in the Brief under the rules and provided with the opportunity to correct the deficiency". As noted in the remand, "This Remand is not made for the purpose of directing the Examiner to further consider the grounds of rejection" (page 3 of Remand).

The Examiner notes that a verbal agreement was reached on September 6, 2007 to cancel claim 2 to expedite the return of the above identified Application to the BPAI. At that time, the Examiner indicated that such a cancellation could not be performed by the Examiner, but that Appellants would be required to submit an amendment after-final cancelling the claim. As of this date, no such amendment has been received. If Appellants submitted a paper cancelling claim 2 previously, the Examiner requests that Appellants resubmit said paper in response to the Notice of Non-Compliant Appeal Brief.

Attachment: Copy of Remand
dated 8/31/2007.

The opinion in support of the decision being entered today
is *not* binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAZUNARI MOTOHASHI

Appeal 2007-1681
Application 10/613,371
Technology Center 1700

Decided: August 31, 2007

Before CHARLES F. WARREN, PETER F. KRATZ, and
CATHERINE Q. TIMM, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

Applicants appeal to the Board from the decision of the Primary Examiner finally rejecting claims 1 through 3 in the Office Action mailed May 26, 2006 (Office Action). 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 41.31(a) (2006).

We remand the application to the Examiner for consideration and explanation of issues raised by the record. 37 C.F.R. §41.50(a)(1) (2007);

Appeal 2007-1681
Application 10/613,371

Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 5, August 2006).

The record shows that included in the grounds of rejection set forth in the Office Action was a ground of rejection of claim 2 under 35 U.S.C. § 112, first paragraph (Office Action 2-3).

Appellant did not request review of this ground of rejection or present argument with respect thereto (Br. 4; *cf.* 8, arguing a ground of rejection of claim 3 under 35 U.S.C. § 103(a) not set forth at 4).

The Examiner did not notify Appellant of this deficiency under 37 C.F.R. § 41.37(d) (2006). The Examiner states the “112 1st Paragraph rejection of claim 2” has “not been withdrawn by the examiner, but . . . [is] not under review on appeal because . . . [it has] not been presented for review in the appellant’s brief” (Answer 4). In responding to Appellants’ arguments with respect to the ground of rejection of claim 2 under 35 U.S.C. § 103(a), the Examiner states “Appellants have not addressed the interpretation given to claim 2, given the pending 112 1st Paragraph rejection on the subject matter of the claim,” and presumes Appellant agrees with the Examiner’s interpretation (*id.* 13-14).

37 C.F.R. § 41.37(c)(1)(vi) and (vii) (2005) provide that the Brief must set forth a “statement of each ground of rejection presented for review” and “[t]he contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section,” respectively. *See also* MPEP § 1205.02 (8th ed., Rev. 3, August 2005). Where Appellant does not present a ground of rejection for review in the Brief, the appeal is considered to be withdrawn with respect to that ground

Appeal 2007-1681
Application 10/613,371

and the “withdrawal is treated as an authorization to cancel the withdrawn claims.” MPEP §§ 1214.05 and 1215.03 (8th ed., Rev. 5, August 2006).

37 C.F.R. § 41.37(d) (2006) provides that Appellant will be notified of any deficiency in the Brief under the rules and provided with the opportunity to correct the deficiency. *See* MPEP § 1205.03 (8th ed., Rev. 5, August 2006).

Accordingly, the Examiner is required to take appropriate action consistent with current examining practice and procedure to notify Appellant of the deficiency in the Brief with respect to the ground of rejection under 35 U.S.C. § 112, first paragraph, and provide Appellant with the opportunity to cure the same in order to avoid withdrawal of the appeal and its consequences with respect to appealed claim 2, with a view toward placing this Application in condition for decision on appeal with respect to the issues presented.

This Remand is *not* made for the purpose of directing the Examiner to further consider the grounds of rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) (2007) does not apply.

We hereby remand this application to the Examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

REMANDED

clj

Appeal 2007-1681
Application 10/613,371

ROBERT J. DEPKE
LEWIS T. STEADMAN
ROCKEY, DEPKE & LYONS, LLC
SUITE 5450 SEARS TOWER
CHICAGO, IL 60606-6306